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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,396	12/18/2001	Bradley S. Emalfarb	254.00069	4852

7590

09/12/2003

WOOD, PHILLIPS, VAN SANTEN, CLARK & MORTIMER
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EXAMINER

GORDON, RAEANN

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 09/12/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

10/025,396

Applicant(s)

EMALFARB, BRADLEY S.

Examiner

Raeann Gorden

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 30 and 31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18, 26 and 27 is/are rejected.
- 7) ☒ Claim(s) 19-25, 28 and 29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election of Group I in Paper No. 3 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, 7-15, 17, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Winskowicz (5,938,544). Regarding claim 1, Winskowicz discloses a golf ball comprising an outer surface comprising a material that changes in diameter and shape when exposed to water for several days (col. 1, lines 65-67; col. 3, lines 34-47; col. 4, lines 53-56). Regarding claim 2, the golf ball has dimples (fig 2). Regarding claim 3, the golf ball includes a core and cover (col. 4, lines 25-28). Regarding claim 4, the

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thickness of the cover is less than one third of the radius of the entire golf ball (see figs 3-4). Regarding claim 5, the material is included over the entire surface of the golf ball (col. 3, lines 34-47). Regarding claim 7, the material comprises a polymer (col. 49-50). Regarding claim 8, the material changes when the golf ball is exposed for several days (col. 1, line 67). Note: the time period is method of using the product and is not relevant to the structure. Regarding claim 9, the material changes by dissolving (melting) (col. 4, lines 5-12). Note: "melting" is a method of using the product and is not relevant to the structure. Regarding claim 10, Winskowicz discloses a golf ball comprising an outer surface comprising a material that changes in diameter and shape when exposed to water for several days (col. 1, lines 65-67; col. 3, lines 34-47; col. 4, lines 53-56). Regarding claim 11, the material changes by dissolving (melting) (col. 4, lines 5-12). Note: "melting" is a method of using the product and is not relevant to the structure. Regarding claim 12, the golf ball has dimples (fig 2). Regarding claim 13, the golf ball includes a core and cover (col. 4, lines 25-28). Regarding claim 14, the thickness of the cover is less than one third of the radius of the entire golf ball (see figs 3-4). Regarding claim 15, the material is included over the entire surface of the golf ball (col. 3, lines 34-47). Regarding claim 17, the material comprises a polymer (col. 49-50). Regarding claim 18, the material changes when the golf ball is exposed for several days (col. 1, line 67). Note: the time period is method of using the product and is not relevant to the structure.

Claims 1, 6, 10, and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Winskowicz (6,358,160). Regarding claims 1 and 10, Winskowicz discloses a golf

ball comprising an outer surface comprising a material that changes in diameter and shape when exposed to water for several days. Regarding claims 6 and 16, the material cover less than the entire surface of the golf ball (figs 9-10).

Claims 26 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamazaki et al (5,447,314). Yamazaki discloses a golf ball comprising at least capillary communicating from a hollow core to the cover.

Allowable Subject Matter

Claims 19-25, 28, and 29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raeann Gorden whose telephone number is 703-308-8354. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell can be reached on 703-308-2126. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

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Raeann Gordon
Examiner
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Rg
September 6, 2003